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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/643,120
Filing Date: August 18, 2003
Appellant(s): SPROGIS, DAVID H.

_____
William E. Hilton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/16/2008 appealing from the Office action

mailed 5/1/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,141,530	RABOWSKY	10-2000
6,698,020	ZIGMOND et al	2-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rabowsky (6,141,530) in view of Zigmond et al (6,698,020)

Regarding claims 1, 3, 5, 7, 8, Rabowsky discloses a system and method for

providing advertisement information to an audience. In particular, Rabowsky teaches

that cinema files are digitized and distributed to theaters electronically for playback. A

automated scheduling system is provided in order to automatically play selected

advertising with the actual timed movie showings as an assembled presentation

[abstract, 1:61 to 2:5, 7:37-49, 12:8-29]. Rabowsky is taken to provide an enabling

disclosure for compiling and assembling a presentation data package (ads + movie) at

the headend. Rabowsky states the ability to request headend changes such as

insertion of ads targeted to the theater location, yet it is not clear whether the targeted

ads are manually or automatically selected and compiled. While Rabowsky teaches the

ability to compile a collection of scheduled ads and the movie for each showing, he

does not teach how and which particular ads are chosen for inclusion into the compiled

presentation data package. While Rabowsky's movie advertising schedule is clearly

automated in terms of playback, he lacks specific teachings for automating the selection

of scheduled ads; it is unclear how the ads are chosen for inclusion in the schedule.

Zigmond et al teaches a system where video programming is provided with selected

targeted advertising. Zigmond et al teaches that conventional prior art systems choose

targeted ads based upon location [2:40-43] and that targeted ads can also be selected

based upon the content of the video programming, location of the showing,

characteristics of the viewer, local time, etc. and then subsequently displayed at the

appropriate time [4:25-48]. This selection is accomplished by automatically comparing

criteria (that has been entered/input and stored) regarding the audience, showing

location and matching that with (input and stored) advertisement metadata/criteria

representing the type of audience, type of location, etc. desired by each stored

advertisement submitted by the advertiser [col 10-12]. This provides a system whereby

job requests are submitted and the system automatically selects appropriately targeted

ads for each movie showing. It would have been obvious to one of ordinary skill at the

time of the invention to have created the advertising schedule of Rabowsky using

similar techniques (matching stored context metadata concerning the movie content, its

showing location and time with stored metadata describing each stored advertisement)

so that an appropriate subset of the advertisement collection can be associated and

compiled with each actual movie showings. This would provide a more compelling

advertisement experience likely to be more well received by the audience than

untargeted ads, and would provide a system whereby administrators only need to

specify targeting parameters/context/metadata rather than manually build each

presentation data package for every movie showing. Rabowsky further discloses that

the scheduling system includes scheduling and playout of all trailers and data files (e.g.

advertisements)(col 12, lines 8-28). While it is not explicitly disclosed that more than

one job request is associated with an actual movie showing, nor that more than one

actual movie showing is associated with a job request, Official Notice is taken that it is

old and well known for theaters having plural projectors to display a plurality of

advertisements and trailers while the audience is waiting for each projector/theater's

actual movie showing to start. Likewise, it is old and well known that theaters present

many of the same advertisements (e.g. advertising the theater's concession stand) and

trailers to audiences awaiting the start of different actual movie showings. Therefore, it

would have been obvious to one having ordinary skill in the art to select a plurality of job

request for each actual movie showing for each of a plurality of projectors/theaters and

to select a plurality of actual movie showings for each job request in Rabowsky. One

would have been motivated to select more than one advertisement per actual movie

showing in order to keep the audience entertained for the 5-30 minutes they are

awaiting the start of the actual movie showing. One would have been motivated to

select more than one actual movie showing per job request in order to preclude the

need to make unique advertisements and trailers for every possible actual movie

showing. In other words, there would only need to be one advertisement for the

theater's concession stand, not a unique one for each actual movie showing. Official

Notice is taken that it is common within the movie industry to present the

advertisements, trailers, previews, etc. before showing the actual movie. This is done to

ensure that the greatest number of people view this information since many people will

leave the theater as soon as the movie credits begin to roll at the end of the movie. It

also would make no business sense to display an advertisement for the theater's

concession stand at the end of the movie. Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to display the

non-cinema data *in advance* of the movie showing. One would have been motivated to

do this for the reasons discussed above.

Regarding claims 2, 6, it would have been obvious to one of ordinary skill at the

time of the invention to have automatically assembled the advertisements with

consideration for duration parameters, so that the system does not create an endless,

nearly endless, or overly-lengthy advertising prior to the movie. No cinema with and

business sense would provide hours of advertising prior to the movie showing; therefore

it would have been obvious to one of ordinary skill at the time of the invention to have

set time limits for the entirely of the ads by restricting a summation of each ad duration.

Regarding claim 4, Official Notice is taken that users are typically notified that

requests submitted to a computer system have been properly received. It would have

been obvious to one of ordinary skill at the time of the invention to have notified the job-

requesting users that their requests have been properly received by the system so that

the users can be confident the requests were not lost or malformed.

(10) Response to Argument

Applicant argues that there is no disclosure how the trailer is compiled at the

headend. It is clear from Rabowsky that a collection of ads is chosen for a particular

movie showing and that that the proper cinema files are delivered to the proper

movie projector for playback pursuant to the schedule. Applicant recognizes that a

schedule is created a the headend, but notes that a theater operator may make

modifications. Abilities to modify are not taken to be incongruous with examiner's

rejection.

Applicant argues that Rabowsky compiles the trailer at the headend, but does not

teach how the trailer is compiled. Applicant points out that the invention includes

accessing information responsive to two sets of information (context data and show

schedule) as well as assembly of the presentation data. The rejection contemplates

a modified system which automatically selects a subset of ads according to several

(i.e. two sets of information) matching criteria. Examiner has included a more

detailed description of the basis for the rejection as follows regarding these two

points:

Rabowsky is taken to provide an enabling disclosure for compiling and
assembling a presentation data package (ads + movie) at the headend.
Rabowsky states the ability to request headend changes such as insertion of ads
targeted to the theater location, yet it is not clear whether the targeted ads are
manually or automatically selected and compiled. While Rabowsky teaches the
ability to compile a collection of scheduled ads and the movie for each showing,
he does not teach how and which particular ads are chosen for inclusion into the
compiled presentation data package. While Rabowsky's movie advertising
schedule is clearly automated in terms of playback, he lacks specific teachings
for automating the selection of scheduled ads; it is unclear how the ads are
chosen for inclusion in the schedule. Zigmond et al teaches a system where
video programming is provided with selected targeted advertising. Zigmond et al
teaches that conventional prior art systems choose targeted ads based upon
location [2:40-43] and that targeted ads can also be selected based upon the
content of the video programming, location of the showing, characteristics of the
viewer, local time, etc. and then subsequently displayed at the appropriate time

[4:25-48]. This selection is accomplished by automatically comparing criteria (that has been entered/input and stored) regarding the audience, showing location and matching that with (input and stored) advertisement metadata/criteria representing the type of audience, type of location, etc. desired by each stored advertisement submitted by the advertiser [col 10-12]. This provides a system whereby job requests are submitted and the system automatically selects appropriately targeted ads for each movie showing. It would have been obvious to one of ordinary skill at the time of the invention to have created the advertising schedule of Rabowsky using similar techniques (matching stored context metadata concerning the movie content, its showing location and time with stored metadata describing each stored advertisement) so that an appropriate subset of the advertisement collection can be associated and compiled with each actual movie showings. This would provide a more compelling advertisement experience likely to be more well received by the audience than untargeted ads, and would provide a system whereby administrators only need to specify targeting parameters/context/metadata rather than manually build each presentation data package for every movie showing.

Applicant argues that because Rabowsky discloses its schedule of movies must be "authorized" [col 2 lines 2-3], the schedule of movies is not disclosed to be automated. To provide context, the portion relied upon in applicant's arguments includes:

an **automation/scheduling** system which **directs playback of cinema files** in the secure projector systems **as authorized by the management system** [col 1: line 67 to col 2: line 3].

This is the automated *playback* of the schedule that has already been created at the headend. The created schedule defines the cinema files to be shown. The cinema files are described here as "authorized" simply because they have been included in

a schedule. Files/content not in the schedule are *not authorized* to be played. In

other words the schedule itself *IS* the authorization. Nonetheless it is Rabowsky's

above-quoted "management system" which creates (read: authorizes) a schedule of

cinema files to be played. The examiner essentially agrees that Rabowsky's

scheduling process may not be an automated one – but not because Rabowsky's

describes scheduled content as "authorized", but because there is not enough

disclosure to be certain of any automation on the task of choosing cinema files to be

part of the schedule. This is why the rejection is one of obviousness in view of

Zigmond et al. It is also important to note that Rabowsky does clearly teach

automated playback of that which is scheduled/authorized.

Applicant notes that Rabowsky allows for manual insertion of ads into a

schedule, however this is not believed to be a proper teaching *away* from

automating a schedule as suggested by Zigmond et al. In fact allowing for

automation would be seen as an enhancement to Rabowsky rather than a

"frustration of the principles of operation" as applicant argues. Indeed even an

automated scheduling system could allow for manual changes or insertions; the two

are not mutually exclusive. Further, known work in one field of endeavor may

prompt variations of it for use in either the same field or a different one based on

design incentives or other market forces if the variations would have been

predictable to one of ordinary skill in the art [KSR rationale F; *Leapfrog Enterprises,*

Inc. v. Fisher-Price, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007)]. One of

ordinary skill in the art of advertising would have found it obvious to update the

assumed-to-be-manual selection of ads for inclusion in Rabowsky's pre-movie

advertising schedule using automated matching techniques so as to create an

automated and targeted set of ads relevant to the movie showing, thus gaining the

commonly understood benefits of such automation - such as speed, accuracy and

ease of ad selection/scheduling. All this would be accomplished with no

unpredictable results.

    Applicant argues that Zigmond et al does not teach a "schedule of ads", yet he

classifies Zigmond et al as "selecting individual ads for specific time allocated spots

in a programming feed" which sounds like a schedule of ads to the examiner.

However, Examiner notes that Rabowsky already clearly has the desire for a

schedule of ads, but is turning to Zigmond et al for teachings on how to automate

selection of ads for scheduled playback. Applicant argues that "selecting individual

ads for specific time allocated spots in a programming feed" is not the same as

creating a schedule of targeted ads, which is a far more complex undertaking." The

particular number of ads to choose for a single advertising period is not seen as a

terribly complex aspect, and is not seen as non-obvious or beyond one of ordinary

skill.

    Applicant argues that such a combined system would still not achieve the

functionality of [the claims], yet there is no discussion what functionality or claim

limitations in particular have been unaddressed or not fully addressed. Applicant

makes further sweeping statements that "any modification" of Rabowsky would be

contrary to the teachings of Rabowsky and would require substantial impermissible

redesign. Here applicant fails to focus on the *particular* modifications proposed by

the examiner and fails to provide particular reasoning *why* "substantial

impermissible" redesign would be not only necessary, but beyond the abilities of one

having ordinary skill.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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